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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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EXAMINER

FALK, ANNE MARIE

ART UNIT PAPER NUMBER

1632

37

DATE MAILED: 10/07/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

08/963,288

Applicant(s)

NORSTEDT ET AL.

Examiner

Anne-Mari Falk, Ph.D.

Art Unit

1632

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED September 23, 2002 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 5 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☒ they raise the issue of new matter (see Note below);
- (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: 34-36, 41, 42, 46-48 and 50.

Claim(s) objected to: _____.

Claim(s) rejected: 1, 2, 5, 7-11, 15-17, 19-21, 23-32, 39, 40, 44, 45, 49, 52 and 53.

Claim(s) withdrawn from consideration: _____.

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

Anne-Marie Falk
ANNE-MARIE BAKER
PATENT EXAMINER

Art Unit: 1632

Continuation Sheet (PTO-303)

Continuation of 2. NOTE:

The proposed claim amendments, if entered, would require new grounds of rejection under 35 U.S.C. 102(b). Claims 27-32, as amended, define an expression vector anticipated by Yoon et al. (1990). Claim 27 is directed to an expression vector comprising a structural gene encoding a protein, a promoter upstream of and operably linked to the structural gene, and at least one enhancer element consisting essentially of the nucleotide sequence TTCTGAGAA upstream of the promoter. Yoon et al. (1990) discloses such a vector.

The proposed amendment to the specification introduces new matter into the specification. No evidence is offered in support of the proposed amendments to Examples 1, 2, and 3. While it is evident that the sequence that is set forth at page 2, paragraph 3, is 52 bp, not 50 bp, it is not evident that the element used in the experiments was the full 52 bp sequence. The specification as-filed consistently reports that a 50 bp element was used in the experiments presented in Examples 1-3. No evidence has been provided to support the proposed amendment to the specification.

Continuation of 5. does NOT place the application in condition for allowance because:

The arguments presented are directed to the claims as amended, but the proposed claim amendments have not been entered. All rejections are maintained for reasons of record.



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NOTES/COMMENTS:

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